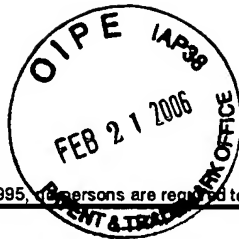


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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

000993A

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Application Number

10/678,225

Filed

October 6, 2003

First Named Inventor

Kenichi HARUKI

Art Unit

2625

Examiner

Sathyanaraya V. Perungavoor

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record. 56,024
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Darrin A. Auito

Typed or printed name

202-822-1100

Telephone number

February 21, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of: **Kenichi HARUKI et al.**

Group Art Unit: **2625**

Serial Number: **10/678,225**

Examiner: **Sathyanaraya V. Perungavoor**

Filed: **October 6, 2003**

Confirmation Number: **2397**

For: **EXTENSION DEVICE PROVIDING SECURITY FUNCTION**

Attorney Docket Number: **000993A**

Customer Number: **38834**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Date: February 21, 2006

REMARKS

Claims 17-19 and 24-26 are pending in the above-identified application. Claims 17-19 and 24-26, which form the basis for this Pre-Appeal Brief Request for Review, stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over *Dickenson et al.*, U.S. Patent No. 6,631,201, in view of *Thomopoulos et al.*, U.S. Patent No. 5,978,495. It is the position of the Office Action that *Dickenson et al.* discloses the invention as claimed except for the disclosure of an identification-information-acquisition device that includes an identification-information-acquisition unit configured to be detachable from the carrier unit in a state of being capable of receiving the identification information. *Thomopoulos et al.* is relied upon to provide the teaching which *Dickenson et al.* lacks.

The issue presented for review is whether *Dickenson et al.* discloses an “identification-information-acquisition unit” as required by claims 17 and 24. Claim 17 specifically requires:

said identification-information-acquisition device comprising an identification-information-acquisition unit which receives identification information... wherein said identification-information-acquisition unit is configured to be detachable from the carrier unit in a state of being capable of receiving the identification information.

Accordingly, to establish a *prima facie* obviousness rejection, the identification-information-acquisition device must comprise an identification-information-acquisition unit.

However, the Examiner has failed to indicate where the identification-information-acquisition unit is actually disclosed or even suggested in the *Dickenson et al.* reference.

Instead, the Examiner merely cites, without comment, ten lines of text, which states the following:

The sensor 5 of the sensor module 2 generates an electronic signal in response to a finger placed on the sensor 5. The electronic signal corresponds to an electronic representation of a tip of a user's finger. As is well known, a human fingertip has a surface that forms a unique pattern of ridges and valleys. This unique pattern of the fingertip, or a print caused when the fingertip is placed on a surface is often referred to as a “fingerprint.” Hereinafter, this term is generally used to refer to the unique pattern of the fingertip and the print caused by the fingertip.

However, this text does not indicate which element of *Dickenson et al.* is the identification-information-acquisition unit. Rather, this text only references the identification-information-acquisition device, which is not the same element (e.g., a simple review of the claims clearly shows that the identification-information-acquisition unit is one element of the identification-information-acquisition device.)

Accordingly, Applicants respectfully submit that the Examiner has failed to present a *prima facie* obviousness rejection, because each and every claimed feature (e.g., identification-information-acquisition unit) is not disclosed by the cited references. Therefore, Applicants respectfully request that the rejection of claims 17-19 and 24-26 be withdrawn.

Also, in the Final Office Action, page 4, the Examiner acknowledged that *Dickinson et al.* does not disclose how the identification-information-acquisition unit is configured to be detachable from the carrier unit in a state of being capable of receiving the identification information. To support the rejection, however, the Examiner remarked that *Thomopoulos et al.* discloses this feature and that it would have been obvious to modify the teachings of *Dickinson et al.* and *Thomopoulos et al.* to configure the identification-information-acquisition unit to be detachable.

However, to properly show that a secondary prior art reference (*Thomopoulos et al.*) would have suggested modifying an element (the identification-information-acquisition unit) of a primary prior art reference (*Dickenson et al.*) to have a particular claim feature (operability when detached from the carrier unit), an Office Action must identify the unmodified element. As stressed by the Applicants in the December 30, 2005 response, the Office Action failed to identify which part of sensor 5 of *Dickenson et al.* is an “identification-information-acquisition unit.” Accordingly, for at least this reason alone, it is clear that the Examiner has failed to present a *prima facie* obviousness rejection.

Regarding the suggestion to modify prior art, the Office Action cited column 6, lines 38-42, of *Thomopoulos et al.* However, this cited portion merely shows that fingerprint scanners

can receive identification information when detached from a computer, if the scanners and the computer are joined using cables. Regardless, even *if* the *Dickenson et al.* laptop 11 were to be modified as suggested by the Examiner, one skilled in the art would be more likely to remove the *entire* interface card 1 (that is, housing 6 and all the contents therein) from slot 9 of the laptop and then connect interface card 1 and laptop 11 using cables. Thus, under this configuration, sensor 5 would not be detached from sensor module 2.

Also, although the Office Action cited the *Thomopoulos et al.* disclosure of scanner 104 as being “detachable” from computer 106 and connectable via cables 108, the Office Action does not explain how *Thomopoulos et al.* supposedly suggests dividing sensor 5 so that a portion is detached from sensor module 2.

In view of the explanations provided above in response to statements provided in the Office Action, Applicants assert that *Thomopoulos et al.* clearly does not support the obviousness rejection. Moreover, Applicants respectfully submit that an explanation that a modification is possible is not an explanation that it would have been obvious. Because the Examiner has failed to provide a proper explanation, the rejection is unjustified for a second reason. Accordingly, withdrawal of the obviousness rejection is now respectfully solicited.

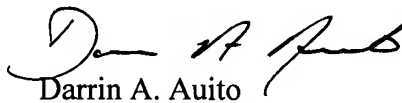
Serial No. **10/678,225**
Attorney Docket No. **000993A**

In view of the remarks set forth above, Applicants submit that the rejection of claims 17-19 and 24-26 is improper. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn and that these claims be passed on to allowance.

If any additional fees are due in connection with this paper, please charge our Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "Darrin A. Auito", is positioned above the printed name.

Darrin A. Auito

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